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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/783,669

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05/29/2002

LEXICON GENETICS INCORPORATED  
8800 TECHNOLOGY FOREST PLACE  
THE WOODLANDS, TX 77381-1160

EXAMINER

CHERNYSHEV, OLGA N

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 05/29/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/783,669

Applicant(s)

WALKE ET AL

Examiner

Olga N. Chernyshev

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the citizenship of inventor N. Wilganowski.

It was not executed in accordance with either 37 CFR 1.66 or 1.68.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is drawn to an invention with no apparent or disclosed specific and substantial credible utility. The instant application has provided a description of an isolated DNA encoding a protein and the protein encoded thereby. The instant application does not disclose the biological role of this protein or its significance.

It is clear from the instant application that the protein described therein is what is termed an "orphan protein" in the art. The DNA of the instant application has been isolated because of its similarity to a known DNA. There is little doubt that, after complete characterization, this

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DNA and encoded protein may be found to have a specific and substantial credible utility. This further characterization, however, is part of the act of invention and until it has been undertaken, Applicant's claimed invention is incomplete. The instant situation is directly analogous to that which was addressed in *Brenner v. Manson*, 148 U.S.P.Q. 689 (Sus. Ct, 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anti-cancer activity was alleged to be potentially useful as an anti-tumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" as it appears in 35 U.S.C. § 101, which requires that an invention must have either an immediate obvious or fully disclosed "real world" utility. The court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and "a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion".

The instant claims are drawn to a DNA and the protein encoded thereby of as yet undetermined function or biological significance. It is clear from the instant application that "The present invention relates to [...] novel human polynucleotides that encode membrane associated proteins and receptors" (page 1, lines 9-11 of the instant specification) designated novel human 7TM proteins NGPCRs. The specification asserts further that "Expression of the described NGPCRs can be detected in spinal cord, kidney, hypothalamus, and particularly in adrenal gland and heart kidney cells, among others" (page 2, lines 13-15). It is also suggested that "The described NGPCRs are transmembrane proteins that fall within the 7TM family of

receptors” (page 4, lines 13-14). However, in the absence of knowledge of the biological significance of this specific polynucleotide and encoded protein, there is no immediately obvious patentable use for the polynucleotide or the encoded protein. The similarity of the disclosed polynucleotide to polynucleotides encoding membrane receptor proteins does not make the instant polynucleotide or encoded protein useful or significant as the known polynucleotides. According to the instant specification, NGPCR proteins can be used, for example, “as reagents in assays for screening for compounds that can be used as pharmaceutical reagents useful in the therapeutic treatment of mental, biological, or medical disorders (*i.e.*, heartbeat rate, etc.) and disease” (page 16, lines 26-31). There is no evidence of record, which associates the instant DNA or encoded protein with any diseases or disorder. Furthermore, it is known from the prior art that in spite of the fact that “a substantial degree of amino acid homology is found among members of [GPCR], but comparisons between subfamilies show significantly less or no similarity” (see Tae et al., page 17299, first paragraph and the whole paper). It is also general knowledge that amino acid structure cannot necessarily predict the function of the protein: “Knowing the protein structure by itself is insufficient to annotate a number of functional classes and is also insufficient for annotating the specific details of protein function” (see Skolnick et al., Box 2 on page 36). There are numerous publications available for review that indicate that even two-amino acid substitution in a molecular structure of a protein can lead to total loss of a protein to bind a specific receptor (see, for example, Yan et al., 2000). Thus, the structural homology of the proteins of the present invention to the proteins with a known function cannot *a priori* be predictive and conclusive of a function of the claimed proteins.

Therefore, to employ the vectors of the invention in the different bacterial systems for expression of NGPCR is not a real world because it would eventually relate to a protein for which no biological function is known. The instant application also fails to demonstrate use of the protein as a marker for any disease or condition (which would be a real world use). Because the instant specification does not teach a biological activity of the protein, one cannot prevent or treat a condition or disease as implied by the specification. To employ a polynucleotide of the instant invention in any of the disclosed methods would clearly be using it as the object of further research, which has been determined by the courts to be a utility, which, alone, does not support patentability. Since the instant specification does not disclose a credible "real world" use for the encoded protein then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 U.S.C. § 101 as being useful.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-4 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a clear asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.
5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated nucleic acid molecule which encodes the amino acid sequence of

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SEQ ID NO:4 and hybridizes under stringent conditions to the complement of the nucleic acid sequence of SEQ ID NO:3, does not reasonably provide enablement for an isolated nucleic acid molecule which encodes the amino acid sequence of SEQ ID NO:4 and hybridizes under stringent conditions to the nucleic acid sequence of SEQ ID NO:3. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Claim 1 encompasses to an isolated nucleic acid molecule which encodes the amino acid sequence of SEQ ID NO:4 and hybridizes under stringent conditions to the nucleic acid sequence of SEQ ID NO:3. The instant application fails to provide necessary guidance to one skilled in the art on how to make a nucleic acid, which essentially encodes SEQ ID NO:4 in both its sense and antisense strand.

6. Claims 2, 3 and 4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 2, 3 and 4 are directed to an isolated nucleic acid expression vector capable of expressing the amino acid sequence. The instant specification fails to describe a method of producing “an isolated nucleic acid expression vector capable of expressing the amino acid sequence”.

According to general knowledge in the art, a nucleic acid expression vector is not capable of expressing an amino acid sequence. Nucleic acids only encode amino acid sequence. Instead, using cells or cell systems achieve the process of expression of amino acid sequences. It would

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require undue experimentation for one skilled in the art to discover how to make the claimed nucleic acid expression vector, which is capable of expressing an amino acid sequence.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite for recitation of “stringent” hybridization conditions. The limitation “stringent conditions” is conditional and the defining conditions are not recited in the claim or the specification.

### *Conclusion*

8. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (703) 305-1003. The examiner can normally be reached on Monday to Friday 9 AM to 5 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Yvonne Eyler can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 782-9306 for regular communications and (703) 782-9307 for After Final communications.



Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)0. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556 or (703) 308-4242. If either of these numbers is out of service, please call the Group receptionist for an alternative number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Olga N. Chernyshev, Ph.D.  
May 28, 2002

OC

JOHN ULM  
PRIMARY EXAMINER  
GROUP 1600